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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,499	07/03/2003	Hugh Herr	H-18	4424
21253	7590	12/02/2009	EXAMINER	
Charles G. Call 20 East Goeth ST CH1 Chicago, IL 60610				BLANCO, JAVIER G
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/613,499	HERR, HUGH	
	Examiner	Art Unit	
	JAVIER G. BLANCO	3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on October 19, 2007; October 13, 2009.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 2,4-8 and 10-25 is/are pending in the application.

4a) Of the above claim(s) 2,4-8,10 and 11 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 12-25 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **October 19, 2007** has been entered.

Response to Amendment

2. Applicant's cancellation of claims 1, 3, and 9 in the reply filed on October 13, 2009 is acknowledged.

3. Applicant's addition of claims 12-25 in the reply filed on October 13, 2009 is acknowledged.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4-8, 10, 11, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding each of claims 4-8, 10, and 11, they depend from cancelled claims.

b. Regarding claim 25, the limitation “*a mechanism for connecting said first spring to said second spring at a predetermined time in said gate cycle*” is indefinite as to the scope of the invention. Figure 7 shows the anterior spring “k” and posterior spring “f” indirectly connected (e.g., via the connection of the “support member”, knee joint “b”, “foot member”). So, which mechanism is the one used “*for connecting said first spring to said second spring at a predetermined time in said gate cycle*”? Further, a “predetermined time” is vague and confusing, rendering claim 25 indefinite as to the scope of the invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 12-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **H. Sartin** (US 2,529,968).

Referring to Figures 1-7, H. Sartin discloses a prosthetic or orthotic leg comprising, in combination,

- a.** A mounting member (13/70) *for attaching* said prosthetic or orthotic leg to a biological limb of a human body,
- b.** A support member (11/41) connected at its upper end at a knee joint (75/72) *for rotation* with respect to said mounting member,

- c. A foot member (10) including a rearwardly extending heel portion (14/15) and a forwardly extending toe portion (18) that make periodic bearing contact with the ground during a walking, running or jumping gate cycle of said human body, said foot member being connected at an ankle joint (34/44 and/or 64/65) to the lower end of said support member *for rotation* relative to said support member,
- d. A first spring (54) *for storing* energy when said support member rotates about said knee joint *to move* said foot member rearwardly with respect to said knee joint and *for releasing* energy *to rotate* said support member about said knee joint *to extend* said support member, and
- e. A second spring (57) *for storing* energy when said support member is rotated about said knee joint *to extend* said support member and *for releasing* energy *to rotate* said foot member about said ankle joint *to increase* the bearing force applied to the ground by said toe portion.

Regarding claims 13-16, 19, 20, and 21, the intended use (or functional) limitations are clearly shown in Figures 4, 5, and 6.

Regarding claims 17 and 22, the "connecting point" is one of 60, 52, 46, 47, and/or 62.

Regarding claims 18, 23, and 24, the figures clearly show the second spring as connected between said foot member and said support member, and capable of storing and releasing energy as said foot member rotates about said ankle joint.

Regarding claim 25, the "mechanism" is one of 46, 47.

With regards to statements of intended use and other functional statements (e.g., *for attaching; for rotation; for storing; for releasing; to extend; etc.*), they do not impose any structural limitations on the claims distinguishable over the device of **H. Sartin**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967)

and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

8. Claims 12-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by

Henschke et al. (US 2,489,291).

Referring to Figures 1-4, **Henschke et al.** disclose a prosthetic or orthotic leg comprising, in combination,

- a.** A mounting member (thigh part 10) *for attaching* said prosthetic or orthotic leg to a biological limb of a human body,
- b.** A support member (**first interpretation:** shank 11; **second interpretation:** connecting element 15) connected at its upper end at a knee joint (knee joint 13) *for rotation* with respect to said mounting member,
- c.** A foot member (foot part 12) including a rearwardly extending heel portion and a forwardly extending toe portion that make periodic bearing contact with the ground during a walking, running or jumping gait cycle of said human body, said foot member being connected at an ankle joint (ankle joint 14) to the lower end of said support member *for rotation* relative to said support member,

d. A first spring (Figure 1: spring 23; Figure 3: spring 60) *for storing* energy when said support member rotates about said knee joint *to move* said foot member rearwardly with respect to said knee joint and *for releasing* energy *to rotate* said support member about said knee joint *to extend* said support member, and

e. A second spring (Figure 1: spring 42) *for storing* energy when said support member is rotated about said knee joint *to extend* said support member and *for releasing* energy *to rotate* said foot member about said ankle joint *to increase* the bearing force applied to the ground by said toe portion.

Regarding claims 13-16, 19, 20, and 21, see columns 5-8 describing the intended use (or functional) limitations.

Regarding claims 17 and 22, the "connecting point" is one of fulcrum 16 and/or rod 24.

Regarding claims 18, 23, and 24, the figures clearly show the second spring as connected between said foot member and said support member, and capable of storing and releasing energy as said foot member rotates about said ankle joint.

Regarding claim 25, the "mechanism" is strap 38 and/or cord 39.

With regards to statements of intended use and other functional statements (e.g., *for attaching; for rotation; for storing; for releasing; to extend; etc.*), they do not impose any structural limitations on the claims distinguishable over the device of **Henschke et al.**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not

what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:00 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, David Isabella can be reached on **(571)272-4749**. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 3774

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/Javier G. Blanco/

Examiner, Art Unit 3774

/David H Willse/

Primary Examiner, Art Unit 3738